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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,255	03/25/2004	Brad Caroline	21604	6903

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EXAMINER	
FLETCHER III, WILLIAM P	

ART UNIT	PAPER NUMBER
1762	

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/809,255	CAROLINE ET AL.	
	Examiner	Art Unit	
	William P. Fletcher III	1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 March 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: the CROSS-REFERENCES TO RELATED APPLICATIONS should be updated to reflect that 10/603,882 has issued as US 6,767,580 B2.

Appropriate correction is required.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. **Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,767,580 B2.** Although the conflicting claims are not identical, they are not patentably distinct from each other:

a. In instant claim 1, the protective material is heated from a temperature of 20 degrees Fahrenheit to 120 degrees Fahrenheit; while in the patent, the protective material is heated from a temperature of 40 degrees Fahrenheit to 120 degrees Fahrenheit. From this it is clear that the claims in question anticipate one-another at least by the teaching of

a common end-point at 120. Anticipation is the epitome of obviousness. Further, differences in temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such temperature is critical. See MPEP 2144.05.

b. In instant claim 2, between 52% to 75% by weight of the pre-polymer mixture and between 25% to 52% by weight of the curative mixture is recited; while in the patent, between 49% to 52% by weight of the pre-polymer mixture and between 49% to 52% by weight of the curative mixture is taught. Again, these claims anticipate one-another at least by the teaching of a common end-point at 52%. Further, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. See MPEP 2144.05.

4. **Claims 10 and 17, 11 and 18, 12 and 19, and 13 and 20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 3, and 4, respectively, of U.S. Patent No. 6,623,805 B2.** Although the conflicting claims are not identical, they are not patentably distinct from each other. The instant claims read on the patented claims except that the instant claims do not recite a bathtub and shower pan fixture or a specific drying time of the protective material. It is the examiner's position that the bathtub/shower pan is merely a recitation of intended use. Because the same method steps are recited, the instant claims are capable of coating such a surface. See MPEP 2111.02. Further, it is the examiner's position that the drying time is a result-effective variable effecting the degree/thoroughness of drying. Absent a showing of unexpected results demonstrating the

criticality of the claimed drying time, it would have been obvious to one of ordinary skill in the art to modify the instant claims so as to optimize this result-effective variable. See MPEP 2144.05.

Allowable Subject Matter

5. The instant claims have been rejected under obviousness-type double patenting as set-forth above. The subject matter recited therein, however, is allowable. The reasons for allowance are the same as those in parent 10/603,882; the prior art neither teaches nor reasonably suggests re-use of the intact protective coating without the application of releasing agent or new protective coating materials.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Liddell et al. (US 5,851,618 A) continues to be the closest prior art of record, but neither teaches nor suggest the allowable features noted above.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571) 272-1419. The examiner can normally be reached on Monday through Friday, 9 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P. Beck can be reached on (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WPF 9/14/2004
William P. Fletcher III
Examiner
Art Unit 1762

STEVE P. BECK
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700